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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,111	09/17/2003	Patrick Bernardelli	PC25382A	9341

28523 7590 02/05/2007  
PFIZER INC.  
PATENT DEPARTMENT, MS8260-1611  
EASTERN POINT ROAD  
GROTON, CT 06340

EXAMINER
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TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
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1624

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/667,111

**Applicant(s)**

BERNARDELLI ET AL.

**Examiner**

Tamthom N. Truong

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3,5,6,8-11,13,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3, 5, 6, 8-11, 13, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## FINAL ACTION

Applicant's amendment of 10-26-06 has been fully considered. In view of applicant's remarks regarding variable R, the previous rejection of 112/2<sup>nd</sup> is now withdrawn. The deletion of "solvates and hydrates" in claim 18 also has overcome the previous rejection of 112/1<sup>st</sup>. Likewise, the amended claim 13 has also overcome the previous rejection of 112/1<sup>st</sup>. Thus said rejection is also withdrawn.

However, applicant's argument and comparison have not overcome the previous rejection of Obviousness-type Double Patenting (ODP). Therefore, said rejection is maintained herein.

Claims 1, 2, 4, 7, 12 and 14-16 are cancelled.

Claims 3, 5, 6, 8-11, 13, 17 and 18 are pending.

## Double Patenting

The **nonstatutory double patenting** rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 3, 5, 6, 8-11, 13, 17 and 18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 29-34, 36-43, 45 and 47 (or final claims 1-6, 8-15, 17 and 19) of the recently allowed U.S. Application No. 10/ 852,404 . Although the conflicting claims are not identical, they are not patentably distinct from each other because instant formula I overlaps with formula I of the allowed application having the following substituents:

- i.  $X_1, X_2, X_3$  and  $X_4$  is  $CR^1$ ;
- ii.  $R^1$  is  $Q_1$ ;
- iii.  $Q_1$  is hydrogen, halogen or  $OR^2$ ;
- iv.  $X$  is  $NR^9$ ;  $R^9$  is hydrogen;
- v.  $Y$  is  $NR^{12}$ ;  $R^{12}$  is hydrogen;
- vi.  $Z$  is O;
- vii.  $A$  is a 5-, 6- or 7-membered ring.

Note, the overlapping subject matter is still found in choice (c) of the definition of  $R^2$  wherein the  $(C_1-C_6)$ alkyl group is substituted with  $SR^{4a}$ , which corresponds to  $Q_1$  (of the copending application) as  $OR^2$  wherein  $R^2$  interrupted with S.

The instant formula I differs from formula I of the allowed application by not having other alternatives for  $R^1$  (e.g.,  $X^5R^5$ ), or other alternatives in place of  $Z$  (e.g., S or  $NR^{13}$ ), or  $A$  as

an 8-membered ring. However, such a difference constitutes a difference in scope only. Thus, it would have been within the level of one skilled in the art to recognize that the instant formula I is a subgenus of formula I of the allowed application. Therefore, it would have been obvious to select the claimed compound in view of formula I of the allowed application.

### *Claim Objections*

2. Claim 18 is objected to because of the following informalities: the term “preferably” in option (c) in the definition of  $R^2$  raises uncertainty in the intended substituent. Appropriate correction is required.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M, T and Th (9:00-5:30).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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1-29-07

  
**Tamthom N. Truong**  
**Examiner**  
**Art Unit 1624**

  
**JAMES O. WILSON**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**